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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/994,845

Applicant(s)

LABROUSSE ET AL.

Examiner

Kimberly T. Nguyen

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## DETAILED ACTION

### *Claim Objections*

Applicant is advised that should **claims 22 and 23** be found allowable, claims 22 and 23 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### *Information Disclosure Statement*

The information disclosure statement filed June 20, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Specifically, the Non-Patent Literature Documents listed were not submitted by Applicants.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-38** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear where the background layers are located with respect to the sheet and graphical elements.

Art Unit: 1774

In claims 1, 2, 3, 5, 26, 29, 35, 36, and 38, it is not clear how Applicants claim “a non-opaque card” with “background layers having different levels of opacity” and “opaque background layers.” It is not clear if the background layers are actually opaque since the claims shows a non-opaque card.

In claim 2, it is not clear how the graphical elements can be printed on the front and back surfaces of the sheet while also being printed on the “opaque white background layer” and the “translucent white background layer.”

In claims 3-4, it is not clear whether the card comprises multiple background layers, as claim 1 shows, or a single white background layer as shown in claims 3 and 4.

Claims 1-17 and 26-29 are rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as being incomplete for omitting essential structural components of elements, such omission amounting to a gap between the necessary structural connections. See MPEP 2173.05(k) and 2172.01. The omitted structural cooperative relationships are: it is unclear how the “opaque white background layer,” “translucent white background layer,” “graphical elements,” “sheet,” “first colored layer,” “second colored layer,” “first and second sheets of non-opaque material,” “infrared reflecting component,” “polyester film,” “multiple nanolayers,” “filter dye,” “film layer,” and “transparent tint dye” are interrelated and where they are located in the non-opaque card’s structure. *Due to the indefiniteness of the layers’ position in the non-opaque card’s structure, the examiner has interpreted claims 6-16, 26-29, 32, 33, and 35-38 as follows:* In **claim 6**, the card comprises background layer/graphical element/sheet/graphical element/background wherein the “graphical elements” comprise a 1<sup>st</sup> colored layer/a white background layer/2<sup>nd</sup> colored layer. In **claims 7-10**, the infrared-reflecting component comprising 1<sup>st</sup> sheet of non-opaque

Art Unit: 1774

material/polyester film/2<sup>nd</sup> sheet of non-opaque material *or* multiple nanolayers of polyester is understood to be located anywhere in the card of claim 1. In **claims 11-12**, the infrared-reflecting component comprising the filter dye is understood to be located anywhere above the surfaces of the sheet since the graphics are already located on the surfaces of the sheet as in claim 1. In **claims 13-14**, it is understood that the transparent tint dye is on the outer surface of the card since the graphical elements are already located directly on the front and back surfaces of the sheet. In **claims 15-16**, it is understood that the tint dye is located anywhere on or above the surfaces of the sheet since claim 1 already shows that the graphical elements are located directly on the front and back surfaces of the sheet. In **claim 26**, it is understood to show graphical elements/opaque white background *or* opaque white background/graphical elements and graphical elements/translucent white background *or* translucent white background/graphical elements on at least one of the front and back surfaces of the 1<sup>st</sup> and 2<sup>nd</sup> sheet layers. In **claim 27-28**, it is understood that the graphical elements *or* the opaque white background *or* translucent white background are in direct contact with the surfaces of the 1<sup>st</sup> and/or 2<sup>nd</sup> sheet layers. In **claim 29**, it is understood to show opaque white background/graphical elements/sheet/graphical elements/translucent white background *or* graphical elements/ opaque white background/sheet/translucent white background/graphical elements; however, it is not clear where the *third* one of the graphical elements is printed since the opaque and translucent white background layers are already located on the surfaces of the sheet. Claim 29 will also be understood to have the third graphical elements printed directly on the surfaces of the sheet with either of the opaque white background *or* translucent white background on the *other* surface of the sheet. In **claims 32-33**, Examiner understands the card to show that the filter dye is

Art Unit: 1774

laminated to either a first *or* second sheet layer since claim 32 only shows a single sheet layer.

In **claim 35**, it is understood to show graphical elements/opaque white background or opaque white background/graphical elements and graphical elements/translucent white background or translucent white background/graphical elements on at least one of the front and back surfaces of the sheet layer with the filter dye being located anywhere in the card. In **claim 35-37**, it is understood that the graphical elements *or* the opaque white background *or* translucent white background are in direct contact with the surfaces of the sheet layer. In **claim 38**, it is understood to show opaque white background/graphical elements/sheet/graphical elements/translucent white background *or* graphical elements/ opaque white background/sheet/translucent white background/graphical elements; however, it is not clear where the *third* one of the graphical elements is printed since the opaque and translucent white background layers are already located on the surfaces of the sheet. Claim 38 will also be understood to have the third graphical elements printed directly on the surface of the sheet with either of the opaque white background or translucent white background on the *other* surface of the sheet.

In claims 5, 29, and 38, it is not clear how, in claims 1, 18, and 30, the sheet is printed with the graphical elements on *two or at least one* of the surfaces, the front and back, while claims 5 and 29 show that the graphical elements are printed onto *three* different surfaces: opaque white background layer, translucent background layer, and directly on one surface of the sheet without a background layer. Because these claims are not definite, claims 5, 29, and 38 are not examined until further clarification.

In claim 11, it is not clear how the filter dye is located on one of said surfaces when the graphical elements are already located and printed on the front and back surfaces of the sheet.

In claim 13, it is not clear where and how the transparent tint dye is located on the sheet. It is not clear if the transparent tint dye is the same as the “graphical element” or not.

In claim 14, it is not clear how the tint dye is disposed over the entire surface of the one side of the sheet when the sheet is already printed on both surfaces with the graphical elements.

In claim 18, it is not clear how the “plurality of graphical elements” are at least one of the sheet’s surfaces while being printed on “backgrounds.”

In claim 30, it is not clear what is meant by the phrase “a filter dye associated with said sheet layer.”

In claim 30, it is not clear where the “plurality of graphical elements” are located.

It is not clear how claim 30 shows a single “sheet layer” while claim 31 shows “first and second sheet layers.”

Claim 32 recites the limitation “said first and second sheet layers.” There is insufficient antecedent basis for this limitation in the claim.

In claim 33, it is not clear how the filter dye is printed on a surface of the sheet layer while the sheet layer is already printed with filter dye and a plurality of graphical elements. It is not clear where the filter dye is located.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1774

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1-5, 6, 11, and 13-17** are rejected under 35 U.S.C. 102(a) as being anticipated by Kiekhaefer, U.S. Pat. No. 6,296,188 B1.

Kiekhaefer shows a patterned transparent/translucent financial transaction card including a material sheet 22 and one or more layers of a filter on both sides of the card (column 2, lines 17-27) comprising infrared light reflecting filter (claim 5) and/or white colorants, tints (column 2, lines 57-59), filter dyes (claim 39, column 3, lines 14-28), and dyes with different levels of opacity, which may include opaque or translucent colored layers (ink, graphical elements, background layers) (claims 38-40, 48) which are disposed over the material sheet.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

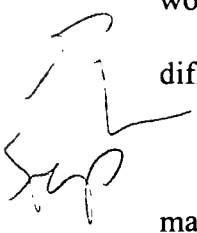
**Claims 7-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiekhaefer, U.S. Pat. No. 6,296,188 B1 in view of Takahashi et al., U.S. Pat. No. 6,261,684 B1.

Kiekhaefer is relied upon as above for claim 1. Kiekhaefer does not specifically show that the infrared-reflecting filter comprises a polyester film as in instant claim 8. Kiekhaefer does not specifically show that the filter is laminated between two sheets of non-opaque material as in instant claim 9. Kiekhaefer does not specifically show that the filter comprises multiple nanolayers with different strengths of reflection as in instant claim 10. Takahashi shows an



Art Unit: 1774

infrared-reflecting transparent film used for adhering to substrates comprising a clear adhesive layer 4, a polyester IR ray reflecting layer 3 (column 4, lines 1-6), a transparent base film 1, and a hardcoat 2 (Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the IR reflecting layer of Kiekhaefer with polyester while being laminated on both sides with a non-opaque material because it is known, as shown by Takahashi, that polyester resins are mixed with filter dyes to make effective IR reflection layers. Further, it would have been obvious to make the IR reflecting layer with multiple nanolayers to provide different levels of a desired IR reflection for the card.

 Kiekhaefer and Takahashi do not specifically show that the infrared light reflecting material reflects and transmits light at the wavelengths as in instant claims 7 and 12. Takahashi does not specifically show that the polyester IR reflecting film comprises multiple nanolayers with different strengths of reflection as in instant claim 10. However, such ranges of wavelengths, numbers of polyester layers, or ranges of strengths of reflection are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ranges, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges, number of layers) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they control the amount of infrared transmittance and reflectance of the card. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the card with the infrared reflecting component and number of polyester layers of the instant invention since it has been held that

Art Unit: 1774

discovering an optimum value of a result effective variable involves only routine skill in the art.

*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

**Claims 18-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiekhaefer, U.S. Pat. No. 6,296,188 B1.

Kiekhaefer shows a patterned transparent/translucent financial transaction card including a material sheet 22 and one or more layers of a filter on both sides of the card (column 2, lines 17-27) comprising infrared light reflecting filter (claim 5) and/or white colorants, tints (column 2, lines 57-59), filter dyes (claim 39, column 3, lines 14-28), and dyes with different levels of opacity, which may include opaque or translucent colored layers (ink, graphical elements, background layers) (claims 38-40, 48) which are disposed over the material sheet.

Kiekhaefer does not specifically show *two* material sheets (first and second sheet layers) as in instant claim 18. However, unless Kiekhaefer teaches away from duplicating the material sheet, it is obvious to duplicate the sheets, motivated by the desire of providing the desired mechanical strength and level of opacity to the financial transaction card.

Kiekhaefer does not specifically show that the filter dye has the minimum absorbance level as in instant claims 20-23 or the filter dyes with the blockage of infrared light as in instant claim 25. However, such ranges of absorbance levels are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the absorbance levels, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are

Art Unit: 1774

optimizable as they control the amount of absorbance of the card. As such, they are optimizable.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the card with the filter dye having the absorbance level of the instant invention since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 24, 31, 33, and 34 are rejected because the phrase “layers are laminated together” in claim 24, “layers that are laminated together” in claim 31, “is incorporated in a solution that is printed” in claim 33, and “is incorporated into the material” in claim 34 introduces a process limitation to the product claims. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

**Claims 30-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiekhaefer, U.S. Pat. No. 6,296,188 B1.

Kiekhaefer shows a patterned transparent/translucent financial transaction card including a material sheet 22 and one or more layers of a filter on both sides of the card (column 2, lines 17-27) comprising infrared light reflecting filter (claim 5) and/or white colorants, tints (column 2, lines 57-59), filter dyes (claim 39, column 3, lines 14-28), and dyes with different levels of opacity, which may include opaque or translucent colored layers (ink, graphical elements, background layers) (claims 38-40, 48) which are disposed over the material sheet. Kiekhaefer

shows that the filter dye is incorporated into a liquid carrier (solution) (claim 35) and the material sheet (column 3, lines 5-7).

Kiekhaefer does not specifically show the filter dyes with the different blockages of infrared light in the range of wavelengths as in instant claim 30. However, such ranges of wavelengths of blockages are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the wavelengths of blockages, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges of wavelengths of blockages) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they control the amount of blockage and opacity of the card. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the card with the filter dyes having the wavelengths of blockages of the instant invention since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 31, 33, and 34 are rejected because the phrase "layers that are laminated together" in claim 31, "is incorporated in a solution that is printed" in claim 33, and "is incorporated into the material" in claim 34 introduces a process limitation to the product claims. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are

Art Unit: 1774

unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen  
Examiner  
February 4, 2003

CYNTHIA H. KELLY  
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